

AMENDMENT

U.S. Appln. No. 09/275,941

Applicants responded in the Amendment under 37 C.F.R. § 1.116 filed February 22, 2001. In the Amendment, entry of which is requested herein, Applicants have cancelled dependent claim 4 and have amended claim 1 to delete the subject matter of cancelled claim 4. In addition, Applicants have cancelled claim 10, since claim 10 is redundant of claim 5.

Upon entry of the amendments, claims 1-3 and 5-9 will be pending in the application.

Applicants submit that the rejection of claims 1 and 4 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ahlheim et al. has been overcome by the amendment to claim 1 and the cancellation of claim 4.

Accordingly, the Examiner is respectfully requested to withdraw the rejection under 35 U.S.C. § 103.

As noted, claims 2-3 and 5-9 are objected to as depending on a rejected claim, i.e., claim 1.

Applicants respectfully submit that the amendment to claim 1 (deleting the subject matter of now-cancelled claim 4) overcomes the objection to claims 2-3 and 5-9.

Accordingly, the Examiner is respectfully requested to withdraw the objection to claims 2-3 and 5-9.

Applicants received a telephone call from the Examiner regarding this application on April 10, 2001. The Examiner stated that there are some patentable claims, but expressed concern that claims 2 and 6 may have a "problem". The Examiner indicated there was some kind of "interference" with another patent. He then said he sees "some prior art compounds he

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didn't see before." He inquired whether Applicants would cancel claims 2 and 6. In a later conversation that same day, the Examiner said that claim 7 may also have a "problem".

It was unclear whether the Examiner was saying he had found additional prior art with respect to claims 2, 6 and 7, or whether he was suggesting that these claims may be suspended from prosecution due to a potential interference.

In view of the situation, Applicants requested the Examiner to send a written Action. Subsequently, Applicants received the Advisory Action dated May 2, 2001.

In the Advisory Action, the Examiner indicates that the Amendment filed February 22, 2001, will be entered upon the timely submission of a Notice of Appeal and Appeal Brief. The Examiner indicates that the Request for Reconsideration has been considered but allegedly does not place the application in condition for allowance for the reasons stated on page 2 of the Advisory Action.

On page 2 of the Action, the Examiner states that the rejection of claims 1 and 4 under 35 U.S.C. § 103 as being unpatentable over Ahlheim et al. and the objection to claims 2-3 and 5-10 as being dependent upon a rejected base claim are maintained as they were applied in the final Office Action mailed November 8, 2000. The Examiner states that the newly proposed amendment in response to the final Office Action has not been entered because it allegedly does not place the application in condition for allowance.

According to the Examiner, the compound of Ahlheim et al. "still reads on claim 1 in the newly proposed amendment." The Examiner states the claimed compound is "a homologue" of

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Ahlheim et al.'s compound. Therefore, the Examiner says, the rejection and objection of the claims are maintained.

While the Examiner indicated on the telephone that he had found new prior art, that does not appear to be the case. The Examiner is relying on the same reference, Ahlheim et al., that he relied on in the past.

Also, the Examiner has not pointed to any problem with claims 2, 6 or 7, which he alluded to in his telephone call.

The Examiner's reasoning in the Advisory Action is unclear to Applicants. On the one hand, the Examiner objects to claims 2-3 and 5-10 as being dependent upon a rejected base claim. In the Action mailed March 23, 2000, the Examiner states that these claims would be allowable if rewritten in independent form. On the other hand, the Examiner alleges (incorrectly, in Applicants' view) that "the compound of Ahlheim et al. still reads on claim 1 in the newly proposed Amendment." This is inconsistent with the Examiner's position that claims 2-3 and 5-9 would be allowable if rewritten in independent form, because the scope of claim 1 as amended corresponds exactly to the scope of claims 2-3 and 5-9 considered collectively.

Further, Applicants cannot understand what the Examiner is confused about. Applicants have claimed a monomer that is different from that of the Ahlheim et al. reference with regard to the steric structure in the 3-position (that is, the position substituted by an acryloyl group in the bile acid skeleton). Applicants claimed (in now-cancelled claim 4) a monomer in which the structure was incorrectly alleged to be identical to the Ahlheim et al. reference (in fact, the steric

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structure is different), but cancelled claim 4 to move the prosecution forward. Accordingly,

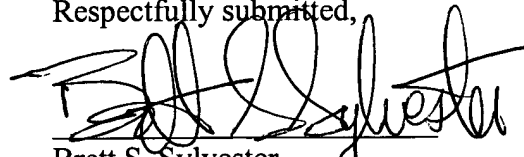
Applicants believe that the controversial feature has been deleted.

In view of the above, the Examiner is respectfully reconsider and withdraw the § 103 rejection of claim 1 and to reconsider and withdraw the objection to dependent claims 2-3 and 5-9.

Allowance is respectfully requested.

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Respectfully submitted,



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